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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,425	11/20/2003	Steven Ryals	BEI-0031US	9644
49584	7590	10/28/2005	EXAMINER	
LEE & HAYES, PLLC 421 W. RIVERSIDE AVE. SUITE 500 SPOKANE, WA 99201			SHARP, JEFFREY ANDREW	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/718,425	RYALS ET AL.
	Examiner	Art Unit
	Jeffrey Sharp	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 August 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 and 23-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17 and 23-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

[1] This action is responsive to Applicant's remarks/amendment filed on 02 August 2005 with regard to the Official Office action mailed on 03 May 2005.

### *Status of Claims*

[2] Claims 1-17 and 23-25 are pending.

Claims 18-22 are cancelled.

### *Drawings*

[3] New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because 37 CFR 1.83(a) requires that the drawings must show every feature of the invention specified in the claims. Therefore, the following limitations must be shown or the feature(s) canceled from the claim(s).

Currently, "boxes" (150) are shown through the interconnecting portion, but the claims refer to these "boxes" as apertures. "Boxes", according to the specification may be indicia such as "symbols, measurements, numerals, etc... or a barcode, loud colors, etc." Nowhere in the specification or drawings is numeral 150 referred to as "apertures". The originally filed claims provide basis for "at least three apertures" through the interconnecting portion, and thus no new matter has been entered.

Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The

corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

I. "wherein the first foot portion has **only one** aperture therethrough" (claims 10, 16, and 17)

II. "at least three **apertures** through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions" (claims 16 and 17)

III. "at least three **apertures** through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions" (claim 9)

No new matter should be entered.

[4] Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

[5] The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification must be amended to provide sufficient antecedent basis for the following limitations:

I. "at least three **apertures** through the interconnecting portion corresponding to and aligned with the apertures of the first and second foot portions" (claims 16 and 17)

II. "at least three **apertures** through the interconnecting portion substantially axially parallel to and aligned with the apertures of the first and second foot portions" (claim 9)

[1] Currently, the specification refers to "boxes" (150) on the interconnecting portion, but the claims refer to these "boxes" as apertures. "Boxes", according to the specification may be indicia

such as "symbols, measurements, numerals, etc... or a barcode, loud colors, etc." Nowhere in the specification is numeral 150 referred to as "apertures" or "at least three apertures". The originally filed claims provide basis for "at least three apertures" through the interconnecting portion, and thus no new matter has been entered.

### *Claim Objections*

[6] Claims 8, 13, and 25 are objected to because of the following informalities:

Examiner notes that it appears Applicant is claiming alternatives in claims 8, 13, and 25. As written, there is some uncertainty as to what each/all the specific alternatives can be. A better wording would be in the form of a Markush Group. A Markush Group and its application are discussed in the MPEP Paragraph 2173.05(h).

Appropriate correction is required.

### *Response to Arguments*

[7] Claims 1-4, 8, and 18-22 were rejected under 35 U.S.C. 102(b) as being anticipated by US-5,314,160 (Larsen). Claims 1, 3-5, and 8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,801,064 (Mangone. Jr.). Claims 1, 3-5, and 8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,573,469 (Golden et al.). Claims 1, 3-5, and 8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 647,169 (Voge1). Claims 1-6 and 8 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 389,660 (Mandel et al.). Claims 1-4, 6, and 8-15 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,913,864 (Walpert). Claims 6

and 7 were rejected under 35 U.S.C. 103(a) as being obvious over any of Mandel et al., Vogel Golden et al., Mangone Jr., and Larsen in view of U.S. Pat. No. 5,620,289 (Curry).

Applicant's arguments, pages 2-4, filed 02 August 2005, with respect to the previous rejection(s) of claim(s) 1-22 have been fully considered, but are moot in view of the substantial amendments made to the claims, and due to further consideration of new art. Therefore, each and every previous rejection under 35 U.S.C. 102(b) and 103(a) have been withdrawn. New ground(s) of rejection appear to the record below.

*Allowable Subject Matter*

[8] After further consideration, the previously indicated allowability of claims 9-17 is withdrawn in view of the new grounds of rejection below.

*New Grounds of Rejection*

*Claim Rejections - 35 USC § 102*

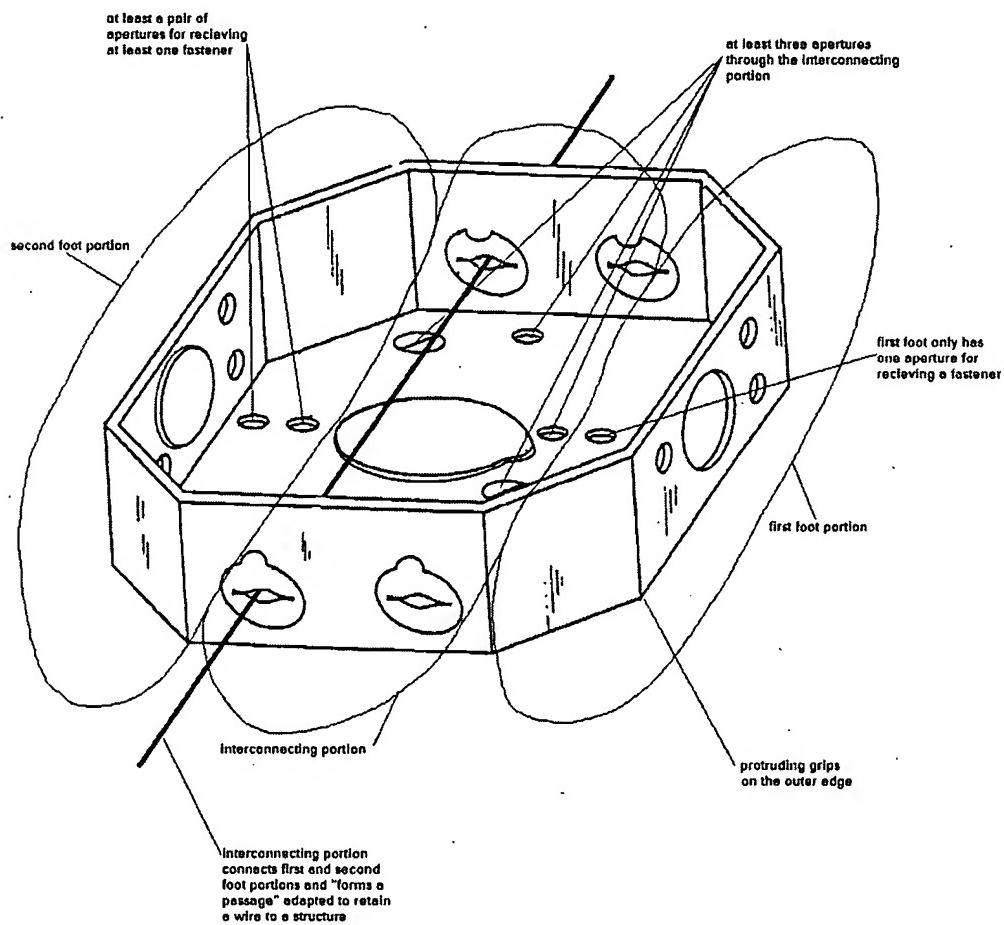
[9] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

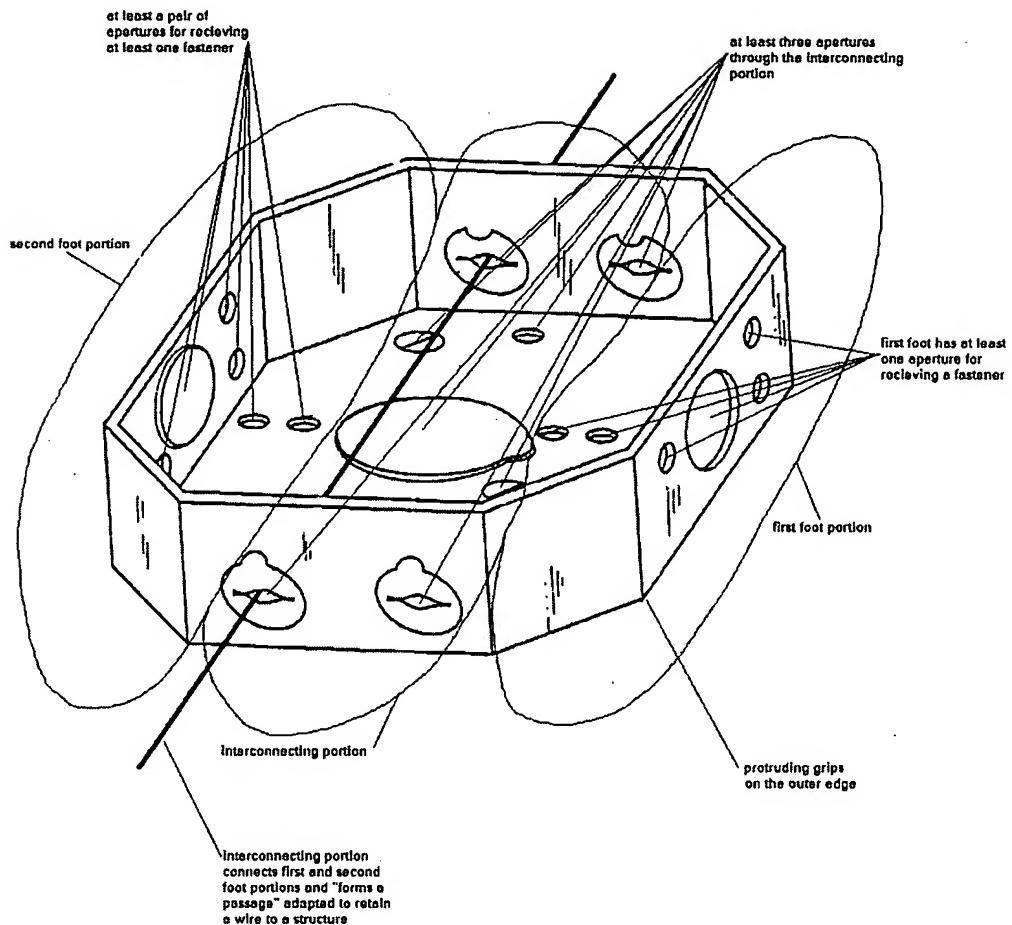
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[10] Claims 1-4, and 8 are rejected under 35 U.S.C. 102(b) as being unpatentable over MacAller et al. US-5,932,844.

In short, when interpreted broadly, MacAller et al. show a molded body (10) designed for securing wire, cables, or the like, having two foot portions with either one or more apertures through them for use with a fastener, comprising an interconnecting portion comprising at least three apertures disposed therethrough. A passage is formed by the interconnecting portion to allow the wire to extend through the molded body. Note that the body is adapted to prevent the at least one fastener from abutting the wire.



Alternatively, one could broadly consider...



### *Claim Rejections - 35 USC § 103*

[11] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

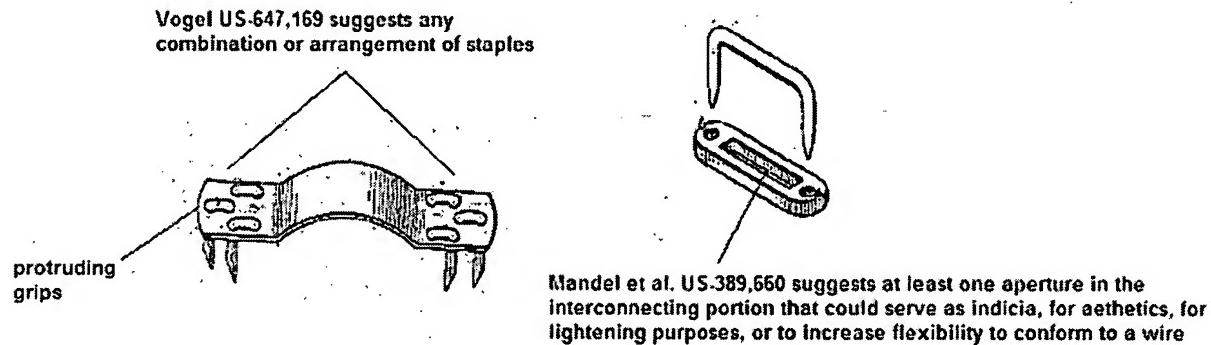
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

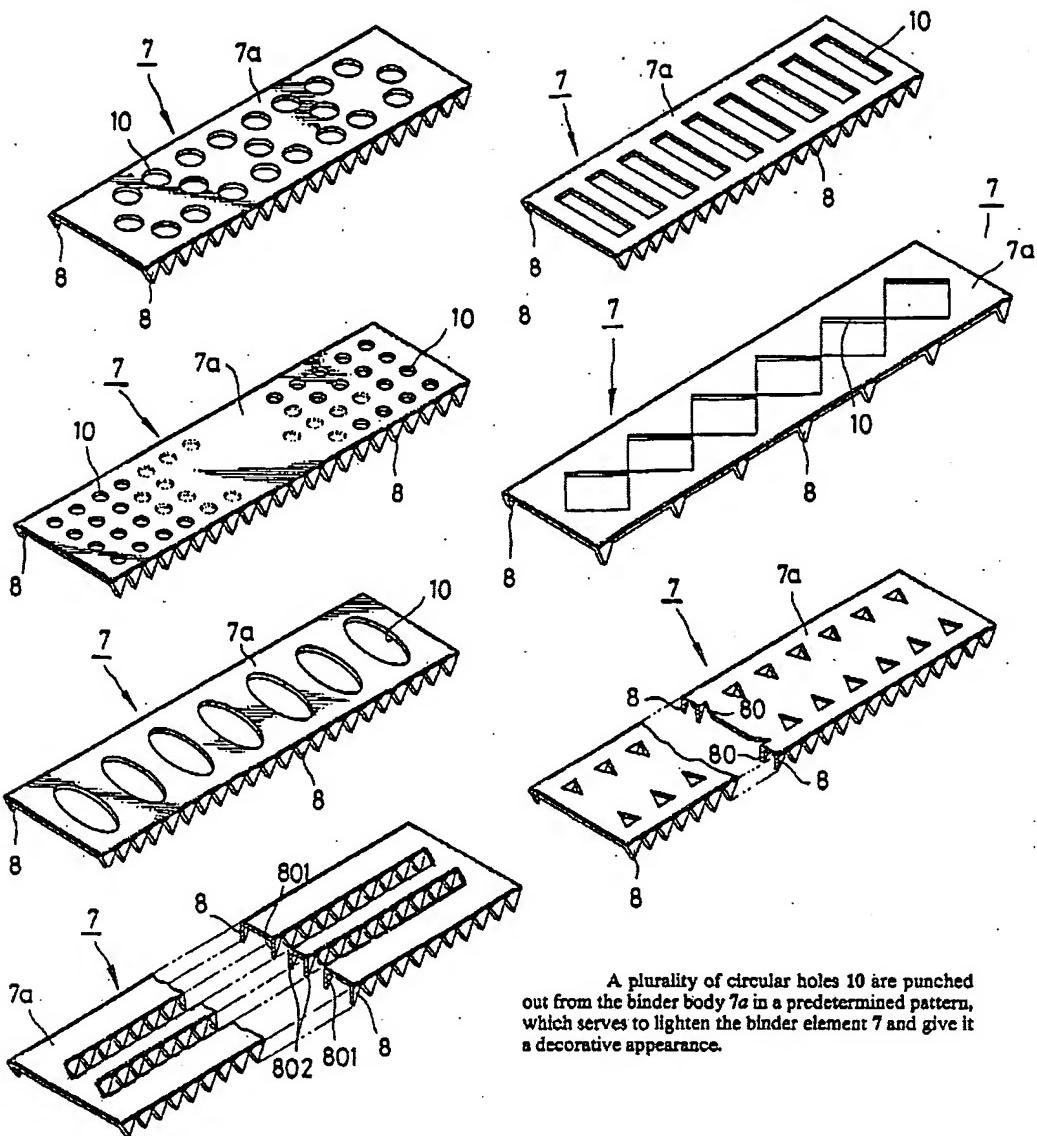
[12] Claims 1-5, 8-15, 17, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel US-647,169 in view of Mandel et al. US-389,660 and Yamaguchi US-4,720,260.

In short, Vogel discloses a moldable body comprising two foot portions having an interconnecting portion that forms a passage for a wire or the like. Each foot portion comprises at least one aperture to receive one or more fasteners (P) that may be wire staples.

However, Vogel fails to comprise "at least three apertures" through the interconnecting portion.

Mandrel et al. suggest at least one aperture (5) through the interconnecting portion which could be used as indicia, and the possibility of "only one" aperture on one of the foot portions.





Yamaguchi suggests placing at least three axially aligned apertures in an "interconnecting portion" in order to provide an ornamental and decorative appearance, and to further lighten the overall weight of the fastener.

At the time of invention, it would have been obvious to one having an ordinary skill in the art, to place at least one aperture in the interconnecting portion taught by Vogel, as suggested by Mandrel et al., so as to 1) serve as lightening holes to reduce the weight of the part, 2) reduce

the amount of material used to make the part, 3) provide a means for viewing the wire through the interconnecting portion, 4) to increase the frictional gripping of a wire beneath the interconnecting portion, 5) provide an aesthetically pleasing appearance, and/or 6) to increase the flexibility of the middle area surrounding the wire so as to better conform to the wire profile<sup>1</sup>. The exact number of holes through the interconnecting portion has no significance other than aesthetic design choice<sup>2</sup>, and it would be obvious in view of Vogel's disclosure that the exact number of holes through each foot portion could be varied depending on the desired holding power<sup>3</sup>.

[13] Claims 6, 7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogel v. Mandel et al. and Yamaguchi (as discussed above), in further view of Whalen US-2,522,656.

Vogel v. Mandel et al. and Yamaguchi suggest all limitations in claims 1 and 16 as discussed above, but are silent as to an advantageous implementation of size indicia on the body.

Whalen (col. 5 lines 13-28) suggests indicia (e.g., color) on a body to serve as a means for indicating the size of a staple, similar to Applicant. Other prior art of record<sup>4</sup> suggests indicia on a staple body rendering this limitation obvious.

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<sup>1</sup> Vogel suggests a flexible material that is preferably lightweight, therefore providing continuity in motivation for placing lightening holes in the interconnecting portion.

<sup>2</sup> As evidenced by Yamaguchi US-4,720,260 col. 4 lines 56-59, which suggests that apertures on an interconnecting portion may be used to lighten the device and to give the device a more desirable appearance.

<sup>3</sup> On lines 1-4 on page 2 of Vogel, it states: "Of course I may vary the number of the prongs (herein "staples") as well as their proportions or arrangement or other features".

<sup>4</sup>e.g., US-6,671,185, US-5,414,991, US-2003/0057697, and US-2004/0126201.

It would have been obvious in view of Whalen's disclosure and the old and well known at the time the invention was made, to employ indicia on a staple body, in order to provide a means for representing fastener size.

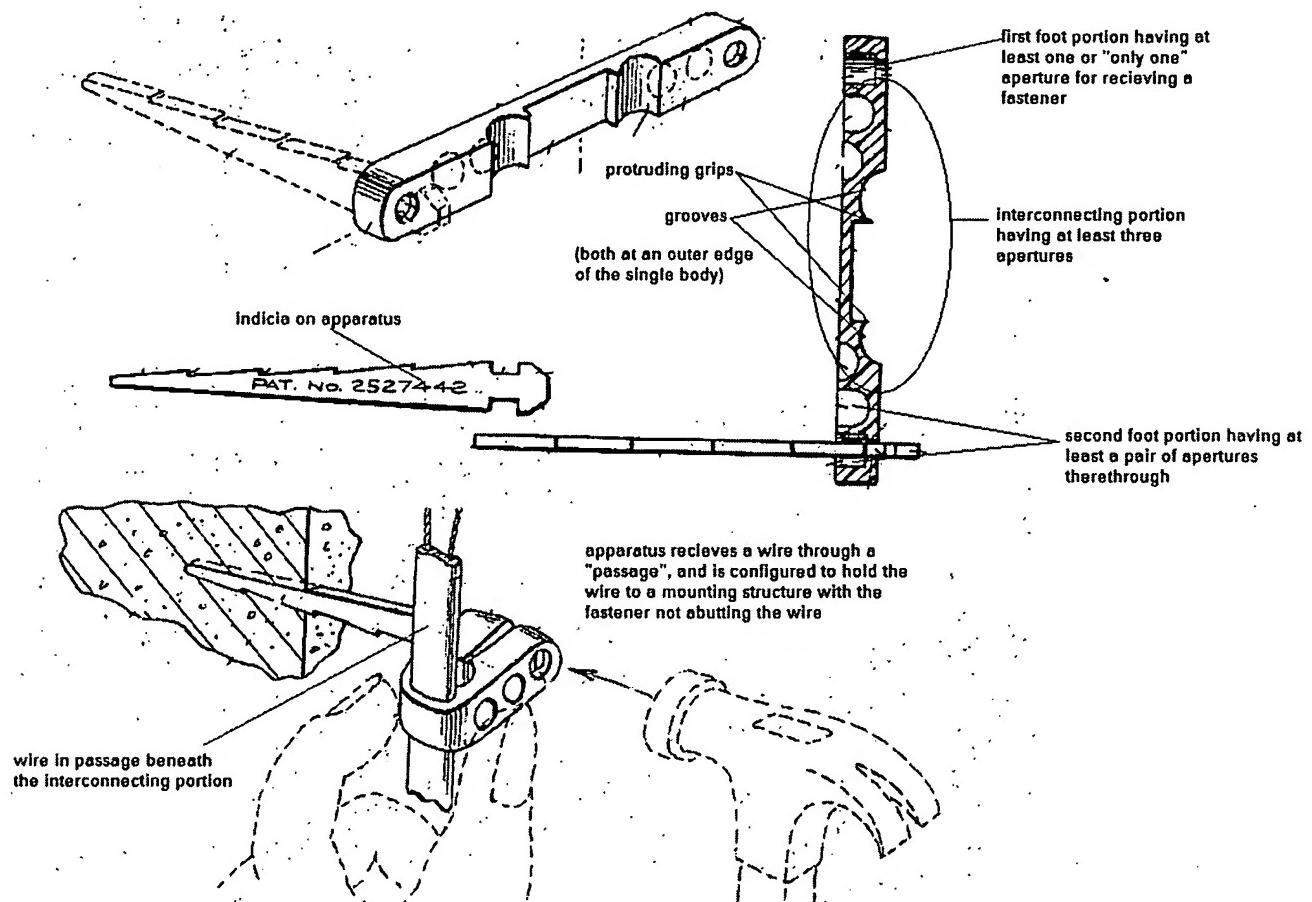
[14] Claims 1, 2, 3, 4, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Larsen US-5,314,160 for the reasons outlined in the previous Office Action.

In short, Larsen suggests a first foot portion having at least one and only one aperture (38) configured to receive a fastener, a second foot portion having at least a pair of apertures (18, 20, 46) configured to receive one or more fasteners (22), and an interconnecting portion (23) configured to retain a wire. Any external portion of Larsen's device would broadly qualify as a "grip" as demonstrated in the figures.

[15] Claims 1, 3, 4, 6-17, and 23-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Odegaard US-3,341,651.

In short, Odegaard suggests a moldable body (10) having a first foot portion with at least one aperture or only one aperture (30,36,30) configured to receive a fastener (40), a second foot portion having at least a pair of apertures (28, 36, 38) configured to receive one or more fasteners (40), and an interconnecting portion between the two foot portions that is configured to retain a wire and which may have at least three apertures (36, 38, 38). Any external portion of

Odegaard's device would broadly qualify as a "grip" as demonstrated in the figures. Note that the apparatus comprises indicia<sup>5</sup>.



### *Conclusion*

[16] Applicant is encouraged to positively claim in more detail the special function and interaction of the apertures, indicia, and the correlation with fastener size and how the indicia are used with the staples. Applicant is also encouraged to more positively recite a kit, combination, and/or how the differently sized staples are located within the molded body with respect to the indicia, and the specific utility of having the specified combination of apertures.

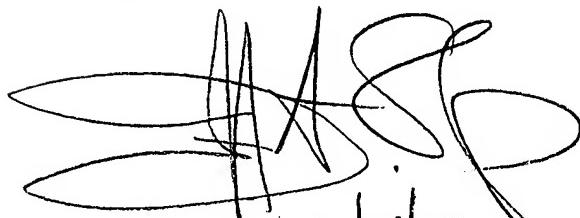
<sup>5</sup> The US Patent Number inscribed in the drawings can be broadly construed as "indicia".

[17] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Sharp whose telephone number is (571) 272-7074. The examiner can normally be reached on 5:30 am - 4:00 pm Mon-Thurs..

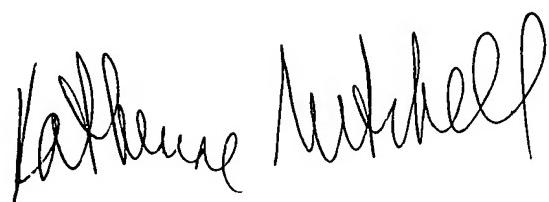
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAS



10/24/05



**Katherine Mitchell**  
**Primary Examiner**